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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/624,451

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Sunmi Chew

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08/03/2006

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EXAMINER

HO, UYEN T

ART UNIT

PAPER NUMBER

3731

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



<b>Office Action Summary</b>	Application No. 10/624,451	Applicant(s) CHEW ET AL.	
	Examiner (Jackie) Tan-Uyen T. Ho	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 January 1949.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/18/04;12/08/03</u> . | 6) <input checked="" type="checkbox"/> Other: <u>IDS 8/25/03</u> .                      |



## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statements (IDS) submitted on 12/8/03 and 8/25/03 are acknowledged and considered.
2. The information disclosure statement filed 3/18/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the IDS form has an incorrect filing date as well as the first named inventor of the application. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Oath/Declaration***

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the mailing address of each inventor. A mailing address is an address at which an inventor customarily receives his or her mail and may be either a home or business address. The mailing address should include the ZIP Code designation. The mailing address may be provided in an application data



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sheet or a supplemental oath or declaration. See 37 CFR 1.63(c) and 37 CFR 1.76.

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either an application data sheet or supplemental oath or declaration.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-148 of copending Application No. 10/306,813. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present invention are anticipated by or obvious variant of the claimed invention of the application '813.



This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 1-49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 43-58, 74-96 of copending Application No. 10/306,813. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present invention are anticipated by or obvious variant of the claimed invention of the application '813.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 20-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20-49 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

- Regarding claims 20-44, providing adjusting means and releasing means for adjusting the length and releasing a deployable portion.



- Regarding claim 45, providing releasing means for releasing the deployable portion.
- Regarding claim 46, providing axially separating means and releasing means for releasing the deployable portion
- Regarding claim 47, providing adjusting means for adjusting the length of the expandable member.
- Regarding claim 48, providing adjusting means and positioning means for positioning a deployable portion in a position for deployment.
- Regarding claim 49, providing deploying means.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-5, 11, 12, 14, 15, 17, 18, 20-29, 35-37, 39, 40, 42, 44-46, 48-49 are rejected under 35 U.S.C. 102(b) as being anticipated by Kugler et al. (6,129,756). Kugler et al. disclose a plurality of stents connected together by graft and the stents being delivered to a target site by a catheter comprising a sheath (108/120, 220, 408/420, 620). As the sheath retracted, the plurality of stents radially expanded at the target site. Fig. 18 of Kugler et al. reference shows, as the sheath of the catheter repositioned/retracted more stent will be deployed along with the graft. At least some stent is retained in the catheter while other stents are deployed (fig. 18, col. 13-15).



Wherein the stents are positioned end to end along the catheter (the claims do not require the stents to contact each other).

Multiple of stents deployed at the same time while other stent is retained in the catheter (col. 15, lines 23-38)

Regarding claims 2 and 3, the deployment mechanism is adapted to deploy a plurality of stent segments (each of stent portion 46 including a plurality of segments) simultaneously. The deployment mechanism being adapted to select one or more of the stent segments for inclusion in the deployable portion as the sheath (120) moving proximally.

Regarding to claim 12, the deployment mechanism having members (124) separate the deployable portion from a remaining portion of the stenting structure.

Regarding claim 15, product by process, the limitation "is severed by the deployment mechanism" is considered but does not result the stenting structure having distinguish structure over the stenting structure of Kugler.

Regarding to method steps, positioning, determining, adjusting and releasing, the stent deployment system of Kugler et al. are configured to perform the steps as claimed.

Regarding claims 26, 27 and 37, the stent segments of portions (46) are indirectly connected together as they are carried on an inner catheter member (100). An inner catheter member (100) or member (124) are considered as separable couplings. The stent segments/portions (46) are unconnected to each other as they are released.



***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 5-9, 30-32, 35, 38, 41, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kugler et al. (6,129,756). Although, Kugler et al. do not disclose the balloon or balloons for delivering the stents, it is well known in the art to have the stents being balloon expanded, self-expanded or both self-expanded and balloon expanded and/or thermal expanded. It also well known in the art to use heat or balloon to expanding the self-expanded stent to a desire diameter for proper anchor the stent to vessel wall. It also well known in the art to have a single balloon or more than one balloon to deliver stents or stent sections. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ of a balloon and/or heat means system into Kugler et al.'s delivering system in order to enhance the expansion of the stent at a deployed site. Doing so would meet all the limitations as claimed.

Regarding to the coil stent, it is well known in the art to have the stent being a coil structure or a mesh structure. Therefore, it would have been obvious matter of design choice to modify the stent of Kugler to have a coil structure since the applicants have not disclosed the advantage of the coil stent over the mesh stent and it appears that the coil stent would perform equally well in the system of Kugler.



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13. Claims 19 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kugler et al. in view of Gifford et al. (6,383,171). Kugler et al. disclose all the limitations of the claims except the deployment system of Kugler et al. is not configured to deploy an everted stent structure. Gifford et al. disclose a system for delivering an everted stent structure in order to reduce the sliding between the stenting structure and the wall of stenting (col. 2, lines 46-55). Therefore, it would have being obvious to one having ordinary skill in the art at the time the invention was made to employ a delivering system for delivering the stent structure evertingly so that to reduce the sliding between the stenting structure and the wall being stented.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



(Jackie) Tan-Uyen T. Ho  
Primary Examiner  
Art Unit 3731

August 1, 2006